

DOCKET NO.: 216597US2PCT/csc



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF:

GROUP: 3621

Adriano HUBER, et al.

SERIAL NO: 09/926,686

EXAMINER: Bradley B. Bayat

RCE FILED: August 8, 2005

FOR: METHOD FOR SELLING AND USING MEDIA OBJECTS AND A DEVICE
SUITABLE THEREFOR

REQUEST FOR PRE-APPEAL BREIF CONFERENCE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s). No more than five (5) pages are provided.

I am the attorney or agent of record.

Respectfully Submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

A handwritten signature in black ink, appearing to read "Michael Monaco", written over a horizontal line.

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IN RE APPLICATION OF :
ADRIANO HUBER, ET AL. : EXAMINER: BAYAT, BRADLEY B.
SERIAL NO: 09/926,686 :
RCE FILED: AUGUST 8, 2005 : GROUP ART UNIT: 3621
FOR: METHOD FOR SELLING AND :
USING MEDIA OBJECTS AND A
DEVICE SUITABLE THEREFOR

**REMARKS ACCOMPANYING REQUEST FOR
PRE-APPEAL BRIEF CONFERENCE**

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

Applicants respectfully request that a Pre-Appeal Brief Conference be initiated in accordance with the pilot program outlined in the Official Gazette Notice of July 12, 2005.

FAILURE TO PRESENT A *PRIMA FACIE* CASE OF OBVIOUSNESS

In the outstanding Office Action, Claims 1-22 were rejected under 35 U.S.C. §103(a) as unpatentable over Downs et al. (U.S. Patent No. 6,226,618, hereinafter "Downs") in view of Zhao et al. (Sigmetrics publication of 5/99 entitled "Bandwidth-Efficient Continuous Media Streaming Through Optimal Multiplexing," hereinafter "Zhao").

Briefly recapitulating, Claim 1 relates to a method for ordering and transmitting digital media objects, including: transmitting an object order for digital media objects that includes at least one object identification by a mobile communications terminal over a mobile radio network to a center, transmitting data on a time at which an ordered media object is available by the center to the communications terminal, *wherein the time is determined by the center with regards to optimal usage of resources used for a transmission of ordered*

media objects and is stored in the communications terminal, *automatically contacting, by the communications terminal, the center at the time*, transmitting a media object assigned to the object identification by the center via a radio network to the communications terminal, where the media object is stored in a memory, and playing back, by a media playback module of the communications terminal, a media content contained in the stored media object. Claim 13 recites similar features in the context of a mobile communications terminal.

Downs describes an automatic metadata acquisition process allowing the retrieval of as much data as possible from the content provider including Digital Rights Management (DRM), without operator assistance.¹ Downs' automatic metadata acquisition process retrieves metadata describing the content, e.g. title, artist, author, composer, producer, or length of recording.² The Office Action asserts that Downs discloses that the communications terminal automatically contacts the center at the stored time. Applicants disagree, since Downs merely describes that a work flow manager 154, located at the content provider 101, is responsible for scheduling content processing activities.³ A work flow manager queuing new jobs at the content provider 101 *is not* a communications terminal automatically contacting the center at a determined time, as recited in Claim 1. Since Claim 1 also recites that the communications terminal plays back the media content, it is not possible that the work flow manager of Downs reads on Applicants' communications terminal.

Furthermore, and as confirmed by the Office Action,⁴ Downs *does not disclose* transmission of media objects at a time for optimal usage of resources. Downs' content provider 101 starts delivering metadata information to an end-user as soon as the end-user

¹ See Downs at column 58, lines 24-29.

² See Downs at column 57, lines 60-63.

³ See Downs from column 49, line 12 to column 50, line 32 and in Figure 1A.

⁴ See the outstanding Office Action at page 3, lines 12-13.

purchases a product.⁵ Accordingly, Downs fails to disclose or suggest that a time of transmitting data is determined by the center with regards to optimal usage of resources used for a transmission of ordered media objects, and also fails to disclose or suggest that the communications terminal automatically contacts the center at the time.

Zhao describes bandwidth-efficient continuous media streaming,⁶ where continuous media are streamed from a media server to a set of distributed receivers.⁷ The server determines a streaming schedule for immediate delivery of a requested media object by the server to a receiver through a continuous streaming process according to the streaming schedule.⁸ However, streaming data with a streaming schedule determined by a server *is not* transmitting data on a time determined by the center with regards to optimal usage of resources used for a transmission of ordered media objects,⁹ as recited in Claim 1. Since Zhao's time of initiating streaming is always $t = 0$, the streaming is intended to start immediately after request. Zhao's schedule thereby adapts the bit rate as a function of time, as shown in Zhao's Figures 5a and 5b. Accordingly, Zhao fails to disclose or suggest automatically contacting the center by the communications terminal at the determined time.

Furthermore, Zhao teaches away from the features of Claim 1 by explicitly stating “[w]e use the term *streaming* to distinguish itself form the alternate approach of downloading and playing back.”¹⁰ “A reference may be said to teach away when a person of ordinary skill in the art, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.” In re Gurley, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994).

⁵ See Downs at column 58, lines 5-9.

⁶ See Zhao in the Title and in the Abstract.

⁷ See Zhao at page 13, column 2, lines 32-35 and in Figures 1 and 2.

⁸ See Zhao at page 15, column 2, paragraph 2.3

⁹ See Zhao at page 15, column 2, lines 10-15 and in Figures 5a-b.

¹⁰ See Zhao at page 14, column 2, lines 12-17.

The Office Action asserts the language of Applicants' claims does not make a distinction between streaming media objects and the features in Applicants' Claim 1.¹¹ However, Claim 1 recites "transmitting a media object ... to the communications terminal, where the media object is stored in a memory," and further recites "playing back ... a media content included in the stored media object." In other words, first a media object is stored, and subsequently, the media content of the media object is played back. In contrast, the definition of the word streaming, as known to one of ordinary skilled in the art and as discussed in Zhao, is:

Playing sound or video in real time as it is downloaded over the Internet *as opposed to storing it in a local file first*. A plug-in to a web browser such as Netscape Navigator decompresses and plays the data as it is transferred to your computer over the World-Wide Web. Streaming audio or video avoids the delay entailed in downloading an entire file and then playing it with a helper application.¹² (Emphasis added.)

Since it is clear from the features of Claim 1 that the media object is first stored in the memory, and then the media content of the media object is played back, Claim 1 is clearly not directed to streaming media content, and Zhao clearly teaches away from such a feature.

In addition, the Office Action asserts "[t]he main feature of the Zhao reference is mechanisms for scheduling a time of transfer of media objects in order [to] optimize efficient bandwidth usage (see pp. 13-14). If in fact media objects were sent immediately, Zhao would not accomplish usage resource optimization."¹³ Applicants respectfully disagree. As explained in the Abstract of Zhao, Zhao's system is directed to media distribution by streaming, and the goal of Zhao is the maximizing of bandwidth efficiency, and not transmitting data on a time at which an ordered media object is available. Nowhere does

¹¹ See the outstanding Office Action at page 3, lines 1-3.

¹² Source: The Free On-line Dictionary of Computing, © 1993-2005 Denis Howe

¹³ See the outstanding Office Action at page 2, lines 15-18.

Zhao disclose or suggest transmitting data on a time at which an ordered media object is available by the center to the communications terminal, as recited in Claim 1.

MPEP §706.02(j) notes that to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Also, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir.1991). Applicants submit that the Official Action does not present a *prima facie* case of obviousness because both Downs and Zhao fail to disclose all the features of Applicants' claimed invention. Furthermore, Zhao teaches away from the proposed combination.

CONCLUSION

Based on the above-noted deficiencies in the outstanding rejections, Applicants request that those rejections be withdrawn or properly supported.

Respectfully submitted,

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